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In re Keller, Terry, and Davies

208 USPQ

him, to do what the inventors herein have done, that is, to use a digital timing circuit in a cardiac pacer. *In re Winslow*, 53 CCPA 1574, 365 F.2d 1017, 151 USPQ 48 (1966), as modified by *In re Antle*, 58 CCPA 1382, 444 F.2d 1168, 170 USPQ 285 (1971). We agree that the references establish a *prima facie* case of obviousness.

The Cywinski Affidavit

[5] Once a *prima facie* case of obviousness was established below, the burden shifted to appellant to rebut it, if he could, with objective evidence of non-obviousness. *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973). Appellant attempted to do so by introducing the Cywinski affidavit. Both this court and the PTO must give full consideration to that evidence and render a decision based on the relative strength of appellant's showing and the *prima facie* case established by the references. *In re Saunders*, 58 CCPA 1316, 444 F.2d 599, 170 USPQ 213 (1971).

Appellant's showing below "may well shift the burden of proof to the examiner to then come forward with further support for his conclusion that the invention would be obvious under the conditions stated in section 103." *In re Katzschmann*, 52 CCPA 1497, 1500, 347 F.2d 620, 622, 146 USPQ 66, 68 (1965). (Emphasis added.) Whether appellant's showing does shift the burden of proof, however, must be determined on a case by case basis.

[6] As characterized by appellant, the Cywinski affidavit offered as objective evidence of non-obviousness "concerns itself mainly with the question of whether the Walsh et al. article suggest [sic] the use of digital timing in a cardiac pacer * * *." But one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Young*, 56 CCPA 757, 403 F.2d 754, 159 USPQ 725 (1968). Moreover, as set forth above, the test is not whether a suggestion to use digital timing in a cardiac pacer is found in Walsh (which was the test applied by Dr. Cywinski), but rather what Keller in view of Walsh and what Berkovits in view of Walsh would have suggested to one of ordinary skill in the art.

Contrary to the position advanced by appellant, *In re Carroll*, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979) is not "nearly 'on fours'" with the present factual situation."

In *Carroll* this court concluded that the opinion of an expert on what the prior art taught was deserving of considerable

deference under the circumstances of that case. The expert had critically reviewed the sole piece of prior art and totally discounted its value. The accuracy of the expert's views was supported by documentary evidence.

[7] In the present case, we are not presented with a single prior art reference, but rather two combinations of three references: Keller in view of Walsh, and Berkovits in view of Walsh. The affidavit does not indicate that Dr. Cywinski critically reviewed the use of digital timing in a cardiac pacer as *prima facie* established by the two combinations of references. Consequently, Dr. Cywinski's opinion on the ultimate legal question of obviousness is entitled to little weight.

Section 103 Rejections are Affirmed

The board considered Dr. Cywinski's testimony and accorded it due weight. We are satisfied that the record herein contains sufficient evidence to support the board's decision. Accordingly, we affirm the decision of the board regarding the §103 rejections.

Requirements of Reissue Declaration

Turning to the rejections under 35 USC 251, we note that a reissue declaration, defective in the nature alleged herein, is correctable in the PTO by the filing of a supplemental oath or declaration.

[8] A reissue oath or declaration filed under 37 CFR 1.175 subsection (a)(4) must also comply with both subsections (a)(5) and (a)(6).¹⁴ Subsection (a) of section 1.175 sets forth requirements relating to the content of a statement which must be filed by the applicant with his reissue application. Subsection (a)(4), which requires the applicant to particularly specify the prior art or other information relevant to patentability and not previously considered by the PTO, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, therefore requires the prior art or other information to be specified in that statement.

In the present case, the reissue declaration purported to incorporate by reference a paper entitled "citation to prior art" on which the prior art being brought to the attention of the PTO by the applicant was delineated. The question before this court, therefore, is whether the citation of prior art was successfully incorporated by reference into the declaration.

¹⁴ See note 4, *supra*.

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[9] Subsection. (a) of section 1.175 re-quires the statement to be made by the applicant under oath or declaration. This statement, therefore, (1) must be subscribed to by the applicant, and (2) must either: (a) be sworn to or affirmed by the applicant as provided in 37 CFR 1.66, or (b) include the personal declaration of the applicant as prescribed in 37 CFR 1.68. See 37 CFR 1.65(a)(2).

In the present case, the declaration per se was subscribed by the applicant and included an appropriate personal declaration of the applicant. The citation of prior art was not subscribed by the applicant and did not include the personal declaration of the applicant. Rather, the citation of prior art was subscribed by applicant's attorney. And, while the citation of prior art is dated one day earlier than the declaration, there is no evidence in the record that applicant even saw the citation of prior art at the time the declaration was executed.

[10] Accordingly, we affirm the decision of the board regarding the rejections of claims 1, 2, 6, 7, and 9-16 under 35 USC 251 because the declaration does not comply with 37 CFR 1.175(a)(4).

As to the rejections on grounds relating to 37 CFR 1.175(a)(5) and (a)(6), we do not agree with the board.

Subsection (a)(5) requires the applicant to specify "the errors or what might be deemed to be errors relied upon, and how they arose or occurred." Subsection 1414.03 of the Manual of Patent Examining Procedure (MPEP) (4th ed., Rev. 1, Jan. 1980)¹⁵ states that to comply with the requirements of subsection (a)(5), in a §1.175(a)(4) type reissue, the reissue declaration

might state that some or all claims might be deemed to be too broad and invalid in view of references X and Y which were not of record in the patent files. Usually, a general statement will suffice. * * * [The reissue declaration] must indicate when and the manner in which the reissue applicant became aware of the prior art or other information. * * *

MPEP §1401.08 (3rd ed., Rev. 54, Oct. 1977) merely stated:

¹⁵ We note that MPEP chapter 1400, the chapter dealing with reissue applications, has been completely revised in the fourth edition and now includes detailed instructions regarding, inter alia, reissue declarations.

The reissue oath or declaration must point out very specifically what the defects are and how the errors arose.

Applicant's reissue declaration contains a passage (which we have numbered "1" in the quoted declaration) that is remarkably close to what subsequently appeared in the fourth edition of the MPEP with respect to the content of a declaration for this purpose. We hold on the facts of this case that the declaration fairly meets the requirements of 37 CFR 1.175(a)(5).

Subsection (a)(6) requires the applicant to state that said errors, if any, arose without deceptive intention on the part of the applicant. The passage in the declaration which we have numbered "3" fairly meets this requirement.

Conclusion

Accordingly, the decision of the board regarding the rejections of claims 1, 2, 6, 7, 9-11, 13, and 14 based on the prior art is affirmed, the decision of the board regarding the rejections of claims 1, 2, 6, 7, and 9-16 based on 37 CFR 1.175 subsection (a)(4) is affirmed, and that based on subsections (a)(5) and (a)(6) is reversed.

*Modified.***U.S. Court of Claims**

Lemelson v. United States et al.

Nos. 414-79C and 415-79C

Decided Nov. 28, 1980

PATENTS

1. **Court of Claims — Pleading and practice (§27.7)**

Pleading and practice in courts — Discovery and inspection (§53.30)

Discovery of nongovernmental sales information from third-party defendants while validity of patent is still in dispute is not necessarily premature; *Kaufman v. United States*, 173 USPQ 806, rejected implicitly underlying rationale of *Burndy v. Sealectro*, 137 USPQ 303, that trial court cannot allow discovery of commercial sales to help establish patent's validity.